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### REMARKS

This is a full and timely response to the outstanding final Office Action mailed October 20, 2005. Through this response, claims 20 and 21 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-9 and 11-19, and 22-48 are respectfully requested.

#### **I. Claim Objections**

Claims 20 and 21 have been objected under 37 C.F.R. §1.75(c), as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant respectfully disagrees, but in the interest of furthering prosecution on the merits of the case, Applicant has canceled claims 20 and 21, thus rendering the objection moot. Applicant respectfully submits that the pending claims are not objectionable, and respectfully requests that the objection be withdrawn.

#### **II. Claim Rejections - 35 U.S.C. § 103(a)**

##### **A. Statement of the Rejection**

Claims 1-9, 11, 12, and 30-39 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Goldhaber et al* ("Goldhaber," U.S. Pat. 5,794,210) in view of *Dedrick* ("Dedrick," U.S. Pat. 5,768,521). Claims 13-29 and 40-48 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Goldhaber*. Applicant respectfully traverses these rejections.

##### **B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima*

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*facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

Applicant respectfully submits that a *prima facie* case for obviousness has not been established.

#### Independent Claim 1

Claim 1 recites (with emphasis added):

1. A server from which a sender distributes content messages to one or more receivers, comprising:
  - a processor;
  - memory;
  - a content packet stored in the memory, the content packet including:
    - message content;
    - a sender bank identifier; and
    - a plurality of values that indicate different amounts based on a manner of rendering that the sender offers to credit a receiver for rendering at least a portion of the message content**, wherein the processor is configured to execute a program, the program configured to construct the content packet and distribute the content packet to the one or more receivers.

Applicant respectfully submits that *Goldhaber* in view of *Dedrick* does not disclose at least the emphasized claim features. The Office Action provides as follows on page 3, section 4 (emphasis added):

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The Examiner notes Claim 1 is directed towards a server with three parts: a processor, memory, and a content package (i.e. data) stored on the memory. Since no action is being taken on the stored data, no patentable weight is given as to what the data is or what type of data it is.

Applicant respectfully disagrees with these assertions, and in particular, disagrees with the assertion that "no action is being taken on the stored data." In Applicant's prior response (dated 7/28/05), independent claim 1 was amended to clarify that the processor, through execution of a program, is indeed acting on the content packet, and thus according to the reasoning provided in the above Office Action cite, patentable weight should be accorded to the data and the type of data.

Additionally, the Office Action asserts that *Goldhaber* "does disclose a server with the same type of data stored thereon." Applicant respectfully disagrees. As explained in Applicant's prior response (dated 7/28/05), *Goldhaber* discloses in col. 10, lines 46-54 the following:

In FIG. 3, the information 56 being provided to the consumer represents an advertisement for other such "negatively priced information." A virtual "price tag" 58 associated with information 56 indicates the amount the information provider will compensate a consumer to pay attention to the information 56. In this example, the consumer uses her computer 104 to read information 56 (and, in some embodiments, to interact with the information thereby evidencing that she has paid attention to it). In response to paying attention to the information 56, the information provider compensates the consumer...

As described, the system in *Goldhaber* provides a single value, and any additional actions are simply evidence of the consumer's attention to the ad that does not warrant additional value.

Additionally, the Office Action asserts the following on page 3, section 4:

Dedrick also discloses an apparatus for presenting content packages to a user that includes a processor and a memory with a content package stored thereon that includes a plurality of values arranged in a pricing hierarchy for advertising information for each advertising message based on how well the user's profile matches the target user's profile (col. 5, lines 47-50).

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Assuming *arguendo* the above assertion to be true, *Dedrick* and *Goldhaber* still fail to disclose, teach, or suggest at least the above emphasized claim features, and thus respectfully request that the rejection be withdrawn.

Because independent claim 1 is allowable over *Goldhaber* in view of *Dedrick*, dependent claims 2-9 and 11-12 are allowable as a matter of law for at least the reason that the dependent claims 2-9 and 11-12 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

### Independent Claim 13

Claim 13 recites (with emphasis added):

13. (Original) An e-mail program stored on one or more computer readable media, comprising:

a receiver module configured to receive a content packet from one or more senders, the content packet including a content message, an advertiser bank account identifier, a value that the sender is willing to pay to render the content message, and finishing instructions detailing how the content message is to be rendered;

*a bank request module configured to verify that an advertiser bank account identified by the advertiser bank account identifier in the content packet can satisfy the value identified in the content packet;*

*a rules module containing payments required to render the content message;*

*a rendering module configured to render the content message if the value meets or exceeds a value established in the rules module and if the bank request module verifies sufficient funds in the advertiser bank account to pay the value included in the content packet; and*

a certification module configured to confirm that the content message has been rendered and to send a certification to the advertiser bank that the content message has been rendered.

Applicant respectfully submits that *Goldhaber* does not disclose, teach, or suggest at least the emphasized claim features. The Office Action makes the following assertions, among others, on page 10 and 11, section 5:

Claims 13, 22, 24, 40, 43, and 45: Goldhaber discloses a method, apparatus, and computer program for presenting content packages to a user, comprising...

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e. Verifying the bank account id and the funds therein (col. 7, lines 48-61);...

While Goldhaber does not explicitly disclose that the user will preset a desired value level for the display value and that the computer program will only display messages with values which meet or exceed that level, it is disclosed that the user presets a number of criteria for the selection of which messages will be selected and displayed when the user is registering with the system. It is also inherent that only a limited number of messages from which to select may be displayed on the user's screen at one time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to also set a minimum limit on the value of the message the user is willing to accept. One would have been motivated to have the user in Goldhaber set such a minimum value level in order to increase the worth of Goldhaber's invention to the user by eliminating low value messages, thus increasing the user's satisfaction with the system.

Applicant respectfully disagrees that the verifying feature is shown or that the rendering module functionality is obvious. With regard to the section (col. 7, lines 48-61) allegedly teaching the bank account verification features, *Goldhaber* provides as follows:

Next to some of the titles on the ad list displayed to Cynthia is the image of a little gold coin--a "consumer interface button" or "CyberCoin"--with a distinctive style. When Cynthia clicks her mouse on the CyberCoin, it opens up the ad and simultaneously causes a transfer of cash or credit directly to Cynthia's desktop (or to a specialized account, credit card or bank account associated with her). This gives Cynthia an important incentive to watch the ad. The ad can include some degree of interactivity (e.g., Forty-Niners game stadium seating preference, choice of diet dessert, etc.) to allow the service to give the advertiser a guarantee that Cynthia paid attention to the ad. This interactivity can make the ad more fun (e.g., by providing a guessing game, quiz or joke).

Nothing in this section discloses, teaches, or suggests *a bank request module configured to verify that an advertiser bank account identified by the advertiser bank account identifier in the content packet can satisfy the value identified in the content packet*. The Office Action responds to this explanation on page 15, section 6(b) as follows:

The Examiner notes that Goldhaber discloses a financial clearinghouse that is "responsible for assuring that consumers pay for some information content delivered to them and are compensated for paying attention to other information content delivered to them" (col 10, lines 1-8). It is inherent that for the financial clearinghouse to assure that the consumer are compensated

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the advertiser bank account must be checked for sufficient funds. Non-existent funds cannot be transferred.

Applicant respectfully disagrees. Assuming *arguendo* a financial clearinghouse checks for sufficient funds, it does not necessarily follow that *Goldhaber* discloses, teaches, or suggests the explicit claim features which require a *bank request module to verify that an advertiser bank account identified by the advertiser bank account identifier in the content packet can satisfy the value identified in the content packet*. Thus, Applicant respectfully requests that the rejection be withdrawn.

With regard to the rendering module feature, Applicant agrees with the Office Action that *Goldhaber* does not explicitly disclose the preset functionality. However, nothing in *Goldhaber* would suggest that criteria entered by a user at registration has anything to do with the value a recipient can receive. Further, col. 5, lines 26-29 asserts the following:

Since all the ads on the list will be targeted to the consumer's needs, interests, and preferences, it is very likely that she would be inclined to view them even without a cash incentive.

This assertion in *Goldhaber* would suggest just the opposite of what is being claimed. That is, since the ads appear to be targeted in *Goldhaber*, any compensation would be desired and certainly not conditional on any preset limits. Given that *Goldhaber* does not disclose, teach, or suggest the emphasized claim features, Applicant respectfully submits that independent claim 13 is patentable over *Goldhaber* and respectfully requests that the rejection to independent claim 13 be withdrawn.

Because independent claim 13 is allowable over *Goldhaber*, dependent claims 14-19 are allowable as a matter of law.

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**Independent Claim 22**

Claim 22 recites (with emphasis added):

22. A printer, comprising:

an e-mail module configured to receive an e-mail message from one or more senders, said e-mail message containing a content packet that includes a content message that is printable on the printer and a print value that identifies a value the sender is willing to pay to print the content message;

a rules module that contains a value required to print the content message *and that is configured to print the content message if the print value is greater than or equal to the value in the rules module;*

*a print confirmation module configured to verify that the content message was printed;* and

*a notice module configured to notify the sender that the content message was printed on the printer.*

Applicant respectfully submits that *Goldhaber* does not disclose, teach, or suggest at least the emphasized claim features. Applicant notes that a *printer* is not even mentioned in *Goldhaber*. Not surprisingly, *Goldhaber* also does not disclose, teach, or suggest *a print confirmation module configured to verify that the content message was printed or a notice module configured to notify the sender that the content message was printed on the printer*, as recited in independent claim 22.

In response to this explanation, the Office Action notes the following on page 16, section 6(c):

The Examiner notes that Goldhaber discloses targeting the advertisements to users who meet the advertiser's targeting criteria and also discloses that the advertiser's could bid on the opportunity to present an advertisement to a user. Thus, it would have been obvious for the advertiser to place (and pay) a higher value on a user who matches more of the targeting criteria than a user who matches less of the criteria. Goldhaber also discloses various means to assure that the user actually viewed or interacted with the advertisement and for sending reports with the tracked information to the advertiser, i.e. notify the sender that the message was received and interacted with (e.g. printed).

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Applicant respectfully disagrees. With regard to the *printer* embodiment, without the benefit of Applicant's disclosure, nothing in *Goldhaber* would motivate one to implement the ad interaction embodiment recited in independent claim 22, since there is simply no discussion in *Goldhaber* of a printer embodiment with the claimed features. Applicant respectfully submits that to assert otherwise would be to improperly engage in hindsight reasoning.

With regard to the print value feature, the Office Action asserts the following:

The Examiner notes that *Goldhaber* discloses targeting the advertisements to users who meet the advertiser's targeting criteria and also discloses that the advertiser's could bid on the opportunity to present an advertisement to a user. Thus, it would have been obvious for the advertiser to place (and pay) a higher value on a user who matches more of the targeting criteria than a user who matches less of the criteria.

Applicant respectfully disagrees. Applicant acknowledges that *Goldhaber* describes demographic profiles that "can be constructed through interest questionnaires." However, as noted in the Office Action (page 11), *Goldhaber* "does not explicitly disclose that the user will preset a desired value level for the display value and that the computer program will only display messages with values which meet or exceed that level." The Office Action asserts that it would be obvious to "allow a user to set a minimum limit on the value of the message the user is willing to accept," and continues that one would have been motivated to have the user set such a minimum value level "in order to increase the worth of *Goldhaber*'s invention to the user by eliminating low value messages, thus presenting only the highest valued messages on the user's screen to increase the user's satisfaction with the system." Applicant respectfully submits that *Goldhaber* simply does not teach or suggest this concept. As described above in association with the discussion of claim 13, col. 5, lines 26-29 of *Goldhaber* makes it clear that the user would be interested in all of the targeted content, making the added threshold feature corresponding to the "*rules module*" an idea spawned more from Applicant's disclosure than any suggestion in the art, and thus the result of improper hindsight reasoning. The statement



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that the advertiser is willing to bid more does not necessarily result in the need or desire for a threshold for its print rendering (which notably, print rendering absent from *Goldhaber*). Although the user may prioritize his or her selection of a particular ad, it is clear from *Goldhaber* that content that reaches the user is all desirable, and thus likely opened with or without compensation. Thus, nothing in *Goldhaber* discloses, teaches, or suggests "***a rules module*** that contains a value required to print the content message and ***that is configured to print the content message if the print value is greater than or equal to the value in the rules module***," as recited in independent claim 22. Given that *Goldhaber* does not disclose, teach, or suggest the emphasized claim features, Applicant respectfully submits that independent claim 22 is patentable over *Goldhaber* and respectfully requests that the rejection to independent claim 22 be withdrawn.

Because independent claim 22 is allowable over *Goldhaber*, dependent claims 23-29 are allowable as a matter of law.

### Independent Claim 30

Claim 30 recites (with emphasis added):

30. A method for distributing content messages to one or more receivers, comprising:

assembling a content packet at a computer device, the content packet including a content message and ***a plurality of rendering values***;

sending the content packet to one or more receivers;

receiving notice that a receiver has rendered a content message from the content packet;

***crediting the receiver that rendered the content message with an amount equal to at least one of the plurality of rendering values based on the manner of rendering.***

Applicant respectfully submits that *Goldhaber* in view of *Dedrick* does not disclose at least the emphasized claim features. As described above in association with independent claim 1, the system in *Goldhaber* provides a single value, and any additional actions are simply evidence of the consumer's attention to the ad that does not warrant additional value. *Dedrick*

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does not remedy these deficiencies for similar reasons recited in association with the discussion of independent claim 1. Since *Goldhaber* in view of *Dedrick* does not disclose the emphasized claim features, Applicant respectfully requests that the rejection to independent claim 30 be withdrawn.

Because independent claim 30 is allowable over *Goldhaber* in view of *Dedrick*, dependent claims 31-39 are allowable as a matter of law.

#### **Independent Claim 40**

Claim 40 recites (with emphasis added):

40. A method for receiving content messages from one or more sender computer devices, comprising:

receiving a content packet from a sender computer device, the content packet containing a content message and a rendering value, the rendering value indicating an amount the sender computer device offers to credit for rendering the content message;

*automatically initiating rendering of the content message if the rendering value is greater than or equal to a pre-determined rendering limit;*

notifying the sender computer device that the content message has been rendered; and

sending credit instructions to the sender computer device to receive credit for the rendering value.

Applicant respectfully submits that *Goldhaber* does not disclose, teach, or suggest at least the emphasized claim features. For similar reasons presented in association with independent claim 22, Applicant respectfully submits that independent claim 40 is patentable over *Goldhaber* and respectfully requests that the rejection to independent claim 40 be withdrawn.

Because independent claim 40 is allowable over *Goldhaber*, dependent claims 41-48 are allowable as a matter of law.

#### **Assertions of Well Known Art**

The Office Action makes various statements of well-known art, such as that found on pages 4 and 5:

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(Page 4 and Page 5) The Examiner notes that the disclosed interacting with the message by the user would encompass all types of interactions to include viewing, clicking on, printing, playing, listening to, or downloading and storing the message. These are well known types of interactions between a user and information being displayed on the user's computer. It is also well known for an advertiser to pay a first amount when a user is initially displayed an advertisement, and then pay a second amount if the user interacts with the advertisement in one of the above mentioned ways. For example, two well known methods for charging advertisers on the Internet are the pay-per-view and the pay-per-click-through methods. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to transfer a first value to the user in Goldhaber upon initially displaying the advertisement and then a second value when the user interacts therewith, such as printing or playing the advertisement. One would have been motivated to pay an additional value to the user in view of Goldhaber's goals of enticing the user to accept advertisements and of tracking the user's interactions therewith.

Similar recitations of well-known art are found on pages 8, 9, and 11-13. Applicant respectfully traverse this finding of well-known art and submits that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required. The Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice/well-known assertions. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

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As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

The Office Action provides the following comments with regard to the Applicant's previous traversal of well-known art on page 17:

The Applicant has not provided any substantial argument or facts on which if any of the above types of interactions are well known. A general statement that the Applicant does not agree with the Officially Noted fact is not a traversal, but merely an opinion. As to providing evidence that a computer user could interact with information presented on his computer in one or more of the above manners, the Examiner invites the Applicant to look at the computer on his desk to determine if it has the normal input and output devices, such as a keyboard, a mouse or trackball, a display screen, speakers, printer, etc., which would be used for "viewing, clicking on, printing, playing, listening to, or downloading and storing messages."

Applicant respectfully submits that in the context of the claim language, such a finding of well-known art is improper given the added complexity associated with the rendering and notification features of the inherited independent claim features. Accordingly, Applicant traverses the Examiner's assertions with regard to well-known use. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the well-known determination.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Goldhaber* and *Dedrick* and that the rejection of these claims should be withdrawn.

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### **III. Canceled Claims**

As identified above, claims 20 and 21 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

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**CONCLUSION**

Applicant respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



**David Rodack**  
**Registration No. 47,034**

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